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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

PATENT & TRADEMARK OFFICE



RE APPLICATION OF:  
Masakatsu MAEDA

SERIAL NO: 10/821,852 GROUP: 1755

FILED: April 12, 2004 EXAMINER:

FOR: EPOXY RESIN COMPOSITION FOR SEMICONDUCTOR SEALING AND  
SEMICONDUCTOR DEVICE

**LETTER**

Mail Stop DD  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Submitted herewith is an International Preliminary Report on Patentability for the Examiner's consideration. The reference cited therein has been previously filed with the International Search Report in an Information Disclosure Statement submitted to the U.S. Patent and Trademark Office on October 4, 2005.

Respectfully Submitted,

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# PATENT COOPERATION TREATY

## PCT

### INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference <b>PCT04023</b>	FOR FURTHER ACTION	See Form PCT/IPEA/416
International application No. <b>PCT/JP2004/005773</b>	International filing date (day/month/year) <b>22.04.2004</b>	Priority date (day/month/year) <b>28.04.2003</b>
International Patent Classification (IPC) or national classification and IPC		
<b>Applicant</b> <b>SUMITOMO BAKELITE CO., LTD.</b>		

<p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of <u>3</u> sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input checked="" type="checkbox"/> (<i>sent to the applicant and to the International Bureau</i>) a total of <u>2</u> sheets, as follows:</p> <p><input checked="" type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).</p> <p><input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.</p> <p>b. <input type="checkbox"/> (<i>sent to the International Bureau only</i>) a total of (indicate type and number of electronic carrier(s)) _____, containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p>																	
<p>4. This report contains indications relating to the following items:</p> <table style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 15%;"><input checked="" type="checkbox"/></td> <td style="width: 85%;">Box No. I Basis of the report</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. II Priority</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. IV Lack of unity of invention</td> </tr> <tr> <td><input checked="" type="checkbox"/></td> <td>Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. VI Certain documents cited</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. VII Certain defects in the international application</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. VIII Certain observations on the international application</td> </tr> </table>		<input checked="" type="checkbox"/>	Box No. I Basis of the report	<input type="checkbox"/>	Box No. II Priority	<input type="checkbox"/>	Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability	<input type="checkbox"/>	Box No. IV Lack of unity of invention	<input checked="" type="checkbox"/>	Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement	<input type="checkbox"/>	Box No. VI Certain documents cited	<input type="checkbox"/>	Box No. VII Certain defects in the international application	<input type="checkbox"/>	Box No. VIII Certain observations on the international application
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Date of submission of the demand	Date of completion of this report
Name and mailing address of the IPEA/JP	Authorized officer
Facsimile No.	Telephone No.

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/JP2004/005773

## Box No. I

## Basis of the report

1. With regard to the language, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.

- This report is based on translations from the original language into the following language \_\_\_\_\_ which is the language of a translation furnished for the purposes of:
- international search (Rule 12.3 and 23.1(b))
  - publication of the international application (Rule 12.4)
  - international preliminary examination (Rule 55.2 and/or 55.3)

2. With regard to the elements of the international application, this report is based on (replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report):

- the international application as originally filed/furnished  
 the description:

pages 1-2, 4-15 as originally filed/furnished

pages\* 3 received by this Authority on 29.11.2004

pages\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_

- the claims:

nos. 5-8 as originally filed/furnished

nos.\* \_\_\_\_\_ as amended (together with any statement) under Article 19

nos.\* 1-4 received by this Authority on 29.11.2004

nos.\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_

- the drawings:

sheets \_\_\_\_\_ as originally filed/furnished

sheets\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_

sheets\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_

- a sequence listing and/or any related table(s) – see Supplemental Box Relating to Sequence Listing.

3.  The amendments have resulted in the cancellation of:

- the description, pages \_\_\_\_\_
- the claims, nos. \_\_\_\_\_
- the drawings, sheets/figs \_\_\_\_\_
- the sequence listing (specify): \_\_\_\_\_
- any table(s) related to sequence listing (specify): \_\_\_\_\_

4.  This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

- the description, pages \_\_\_\_\_
- the claims, nos. \_\_\_\_\_
- the drawings, sheets/figs \_\_\_\_\_
- the sequence listing (specify): \_\_\_\_\_
- any table(s) related to sequence listing (specify): \_\_\_\_\_

\* If item 4 applies, some or all of those sheets may be marked "superseded."

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.  
PCT/JP2004/005773

**Box No. V** Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

**1. Statement**

Novelty (N)	Claims 2	YES
	Claims 1, 3-8	NO
Inventive step (IS)	Claims 2	YES
	Claims 1, 3-8	NO
Industrial applicability (IA)	Claims 1-8	YES
	Claims _____	NO

**2. Citations and explanations (Rule 70.7)**

Document 1: JP 2002-348439 A (Sumitomo Bakelite Co., Ltd.)

Document 1 cited in the international search report indicates that the marking properties of a cured material are improved by the addition of an organic colorant. However, it would be easy for a person skilled in the art to derive the inventions set forth in claims 1, 3-6 and 8 by removing the organic colorant from the invention disclosed in document 1 if the level of marking properties of the compound without said colorant were permissible.

**Claim 2**

The invention set forth in claim 2 is not disclosed in any of the documents cited in the international search report. Moreover, it is not be easy for a person skilled in the art to derive this invention from the disclosures in any of these documents.